

The opinion in support of the decision being entered today was not written for publication and is not precedent of the Board.

Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GEORGE MORTIMER TIFFANY, III, GEORGE CONRAD L'HEUREUX and
JOHN HENRY SMYTHE

Appeal No. 1999-0543
Application No. 08/807,210

ON BRIEF

Before GARRIS, WALTZ and PAWLIKOWSKI, Administrative Patent Judges.
GARRIS, Administrative Patent Judge.

ON REQUEST FOR REHEARING

This is in response to a request, filed September 27, 2001, for a rehearing of our decision, mailed August 31, 2001, wherein we affirmed the examiner's section 103 rejection of all appealed claims as being unpatentable over the Japanese reference in view of Miyaji.

In this request, the appellants reiterate their argument that Miyaji teaches away from using lubricating or mineral oil in compositions for two-cycle engines pursuant to the here claimed invention and accordingly that the examiner's rejection is

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improper. Specifically on page 3 of the subject request, the appellants urge that "the claims cannot stand rejected on the basis of the Japanese reference in combination with Miyaji in that Miyaji cannot be used to support the reference since it clearly teaches in a direction contrary to that achieved in accordance with appellants' invention and this contrary teaching must be given consideration".

We have again carefully evaluated the appellants' above noted position giving full consideration to the applied reference teachings including the particular teachings referred to by the appellants in their request. In this regard, we recognize the appellants point out that Miyaji associates cleanliness problems with the presence of mineral oil in lubricating oil compositions for two-cycle engines (see lines 28-33, in column 1). As indicated in our above noted decision, however, Miyaji expressly discloses using at least some amount of mineral oil in his lubricating oil composition (see the paragraph bridging columns 3 and 4) and therefore plainly does not teach away from the use of any and all amounts of mineral oil in compositions of the type under consideration. Further, as also indicated in our decision, it is significant that the Japanese reference expressly teaches the effectiveness of a two-cycle engine oil composition which

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contains, for example, 40% by weight of mineral oil (see the first full paragraph of translation page 3).

For these reasons and those expressed on page 5 of our decision, we remain convinced that the combined teachings of the applied references would have suggested a composition of the type here claimed which includes, for example, 40% by weight of a lubricating oil (i.e., mineral oil). In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981) (the test for obviousness is what the combined teachings of the references would have suggested to those of ordinary skill in the art).

In addition to the foregoing, it is appropriate to emphasize that the appellants have not contested in the subject request our determination on page 6 of the forenoted decision that the Japanese reference by itself is adequate to establish a prima facie case of obviousness based on the rationale of In re Kerkhoven, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980).

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For the above stated reasons, the appellants' request is granted to the extent that we have reconsidered our decision but is denied with respect to making any changes therein.

DENIED

BRADLEY R. GARRIS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
THOMAS A. WALTZ)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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BEVERLY A. PAWLIKOWSKI)	
Administrative Patent Judge)	

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